

Remarks

The Examiner has rejected claim 45 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 45 depends from claim 44, which depends from claim 43, which depends from claim 39.

Applicant has amended claim 45 to include the limitations of the independent claim from which it depends and all intervening claims. Further, Applicant has amended the preamble of claim 45 to include a dolly "system" which envisions a dolly and a planar guard member. Support for this amendment can be found in Figures 1 and 4, and at page 11, lines 14-17. Applicant believes that claim 45 is now in condition for allowance and respectfully requests such action.

The Examiner has rejected claims 39-44, 46, 48, 49 and 50 under 35 U.S.C. §103(a) as being unpatentable over *Lowry, et al.* (U.S. Patent 4,389,836) in view of *Clark* (U.S. Patent 2,942,397) or, alternatively, *Clark* in view of *Lowry*. Applicant respectfully traverses the rejection of claims 39-44, 46, 48, 49 and 50.

With respect to claim 39, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the dolly of the *Lowry* '836 patent with the wheel receptacles of the *Clark* '397 patent in order to provide a dolly that can support a line trimmer in mowing, trimming and edging positions.

The Federal Circuit has held that all claim limitations must be considered in order to make a proper 103 combination of prior art. A reference does not render the claimed combination *prima facie* obvious if a material limitation has been ignored. *In re Fine*, 837 F.2d

1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *Also See, In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q.2d 1249 (Fed. Cir. 1987). In our case, a limitation of the claims has been left out of the proposed combination of *Lowry* with *Clark*.

The Examiner states that:

The invention of the *Lowry* '836 patent with the invention of the *Clark* '397 patent will provide a dolly that can support a line trimmer in mowing, trimming and edging positions.

However, the combination of the inventions of *Lowry* and *Clark* does not provide a first and second opposed wheel receptacle for receiving wheel mounting brackets for first and second opposed support wheels and a third receptacle for receiving a wheel mounting bracket for a third support wheel for supporting said line trimming apparatus ...*in one of a mower and trimmer configuration...* and fourth and fifth wheel receptacles for receiving wheel mounting brackets for respective support wheels for supporting said line trimming apparatus...*in an edger configuration*. The Examiner makes the argument that a mowing, trimming and edging position is equivalent to the mower configuration, trimmer configuration and edging configuration of the claim. However, if the art is carefully reviewed, it can be seen that both *Clark* and *Lowry* have a single mowing position and a single edging position. There is no trimming position. On the other hand, the claim requires three distinct positions: one of a mower configuration and a trimmer configuration and an edger configuration.

Referring to the specification, Figure 6 shows a mower configuration, Figure 7 discloses a trimmer configuration and Figure 9 discloses an edger configuration. The trimmer configuration is defined at page 14, lines 14-22. The trimmer configuration allows the invention of the application to facilitate:

... traversal of the universal dolly 1 along the fence 42 and allows close cropping or trimming of the grass 43 along and beneath the fence 42...

The inventions of *Lowry* even combined with *Clark* do not disclose or suggest the trimmer configuration required by claim 39. For example, Figure 2 of *Clark* discloses a frame or member 41 having an aperture 21. The rotary blade means 22 shown in Figure 4 cannot reach the edge of member 41 in order to achieve a trimming configuration such as that disclosed by the invention of the application and required by claim 39. Similarly, the platform 26 of *Lowry* is surrounded by a down-hanging edge which would prevent plastic cord 20 from close cropping or trimming of grass in a trimmer configuration as described in the invention of the application and required as a trimmer configuration in claim 39.

The Examiner goes on to state in reference to the rejection of claim 39 that:

Alternatively, it would have been obvious to combine the mower frame of the *Clark* '397 patent with the line trimmer and coupling portion for a line trimmer as disclosed by the *Lowry* '836 patent in order to provide an alternative cutting means that incorporates the portability and versatility of a line trimmer with the stability and ease of a dolly.

However, the invention of *Clark* is not properly combinable with the invention of *Lowry* as suggested by the Examiner because the intended function of *Clark* would be destroyed by the combination.

A Section 103 rejection based on a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, is not proper and the *prima facie* case of obviousness cannot be properly made. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Moreover, there would be no technical motivation for engaging in the modification suggested by the Examiner and, to the contrary, there would be a disincentive to combine *Clark* with *Lowry*. The *Clark* invention requires that T-shaped manually graspable

crossbar (“handle”) 28 be removed from tubular receiver 34 and reinserted in receiver 30 in order to “flip” the *Clark* invention from the orientation shown in Figure 1 to the orientation shown in Figure 6. The invention of *Lowry* requires a handle mount 22 and a handle pole 24 which are nonremovably attached to housing 14. If, as this Examiner suggests, the line trimmer and coupling portion for a line trimmer as disclosed by *Lowry* were combined with the mower frame of *Clark*, the resulting combination would be inoperable because the cart frame would not be capable of functioning in the orientation shown in Figure 6 of *Clark*. The reason is that the handle pole 24 of the trimming device 12 would be facing parallel with the ground in a position which would make use impossible, thereby destroying operability.

With respect to claims 40-42, Applicant respectfully suggests that since claim 39 is allowable and claims 40-42 are dependent on claim 39, claims 40-42 are also allowable. In addition, with respect to claim 41, the Examiner states in reference to *Clark*:

The first (15-rear) and second (15-front) wheel receptacles form a first pair of wheel receptacles projecting in opposite directions from each other...

However, as shown in Figures 1 and 6, the left and right wheels 15 are not carried by receptacles which project in *opposite* directions from each other – rather they are in the *same* direction. As can be seen most clearly with respect to Figure 6, wheel 15 is attached to a shaft (unnumbered) which proceeds through a sleeve (unnumbered) which is parallel to a similar supporting shaft (unnumbered) and supporting sleeve. Therefore, since neither the *Clark* nor the *Lowry* reference disclose the required claim element of 41 that the wheel receptacles project in opposite directions, claim 41 is not obvious in view of this combination.

With respect to claims 43 and 44, claim 43 depends from claim 39 and claim 44 depends from claim 43. Since Applicant believes that claim 39 is allowable, claims 43 and 44 are similarly believed to be allowable.

With respect to claim 46, claim 46 depends from claim 39 which is believed to be allowable; therefore, claim 46 is believed to be allowable.

With respect to claim 48, claim 48 depends from claim 39 which is believed to be allowable; therefore, claim 48 is believed to be allowable.

With respect to claim 49, the Examiner states with respect to Figure 7 of *Clark* that “The axis of the wheel bolt extends *parallel* and is spaced from the stub axle” (emphasis added). However, Figure 7 of *Clark* shows at 15 that the stub axle is *perpendicular* to the wheel bolt. The stub axle of *Clark* is cylindrical and fits through a cylindrical retainer which is, in turn, connected to a flat flange having various holes for adjustment of the height of the wheel. Therefore, *Clark* does not disclose nor suggest an axis of the wheel bolt extending generally parallel to and spaced from the stub axle as required by claim 49. Therefore, claim 49 is believed to be allowable over the art of record.

With respect to claim 47, there is no basis in the art for combining or modifying the references as suggested by the Examiner. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching suggestion or incentives purporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); *Also See, In re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Absent some showing in the prior art, the Examiner has impermissibly used the Applicant’s teaching to search the prior art for the claimed elements

and combine them as taught by the inventor. *In re Zurko*, 111 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997).

In our case, there is no suggestion in the art for making the combination suggested by the Examiner. With respect to *Clark*, there is no need for brace 82 as shown in *Moore* because handle 28 is secured in one of two positions in receivers 30 and 34, as shown in Figures 1 and 6. Further, there is no suggestion in *Clark* to add a brace to handle 28. The additional structure is superfluous. With respect to *Lowry*, an additional handle 31, shown in Figures 1 and 2, eliminates the need for a connection between the dolly and the handle 24. Moreover, there is no suggestion in *Moore* '415 to add the additional handle 28 of *Clark* or the additional handle 31 of *Lowry* because *Moore* '415 envisions using the handle 52 of the trimmer 51. Since there is no suggestion or motivation in *Clark*, *Lowry* or *Moore* '415 to combine the elements as suggested by the Examiner to arrive at those required by claim 47, it is respectfully suggested that claim 47 is allowable over the art of record.

With respect to claims 45, and 51-53, claims 45, and 51-53 depend from claim 44, which depends from claim 43, which depends from claim 39. Since 39 is believed to be allowable, claims 45, and 51-53 are believed to be allowable.

In addition, the Examiner rejects claims 45, and 51-53 as follows:

The combination of *Lowry* '836 and *Clark* '397 patents discloses the claimed invention, as stated in paragraph 6 above, except for the line trimming apparatus also having a generally planar guard member having an opening for the line trimming apparatus and being releasably engaged with the line trimming apparatus through corresponding tabs. The *Pittinger* '339 patent teaches that it is known in the art to provide a line trimming apparatus with a guard removably attached by tabs. It would have been obvious to provide the line trimming apparatus of the combination of the *Lowry* '386 and *Clark* '397 patents with the guard of the *Pittinger* '339 patent in order to provide safety when the line trimming apparatus is used independently of the dolly.

A proper '103 combination cannot be made if the art of record "teaches away" from the combination. In short, teaching away is the antithesis of the art suggesting that a person of ordinary skill go in the claimed direction. Teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Nielson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). In our case, *Pittinger* clearly teaches away from the combination suggested by the Examiner.

Pittinger discloses an invention which is specifically designed to prevent and discourage users from removing the planar guard member. *Pittinger* at column 1, lines 27-30, clearly teaches away from the combination as follows:

...It must also, in accordance with the objects of this invention, be capable of two second, two hand manual assembly, so to speak, without the use of tools while being tamper proof but positive in disassembly to *discourage users from removing the safety shield...*

Clearly, if the user is discouraged from detaching the planar guard member of *Pittinger*, he would not be lead in the direction of attaching either the dolly of *Clark* or *Lowry*.

Similarly, *Clark* teaches away from the claimed combination. For example, *Clark* teaches a rigid attachment of motor means 16 by plates 17 and 18 and braced by brace means 19. Rigid attachment of the motor means to the dolly means of *Clark* affirmatively teaches away from ease of removability. Moreover, the removal of electric motor means 16 destroys the operability of the *Clark* reference because there is no handle with which to use the device.

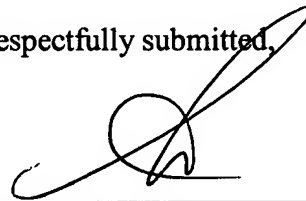
Finally, *Lowry* teaches away from a combination with *Pittinger*. The *Lowry* device, as shown in Figure 1, discloses a motor housing which has a peripheral skirt portion 16. The peripheral skirt portion 16 is equivalent to the generally planar guard member of *Pittinger*. Therefore, *Pittinger* teaches away from adding an additional planar guard member. Moreover,

since *Lowry* already incorporates a planar guard member, there is no motivation to add a second planar guard member. Since the art of record teaches away from a suggested combination or, at the very least, does not suggest or disclose the combination, it is respectfully submitted that claims 45, 51 and 53 are allowable.

If any additional issues need to be addressed, a telephone call to the undersigned attorney would be greatly appreciated.

The Commissioner is authorized to charge any underpayment of fees due with this amendment, or credit any overpayment, to Deposit Account No. 50-2225.

Respectfully submitted,



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